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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/935,844	09/23/97	WILSON R	E0295/7021

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RICHARD F GIUNTA
WOLF GREENFIELD AND SACKS
FEDERAL RESERVE PLAZA
600 ATLANTIC AVENUE
BOSTON MA 02210-2211

EXAMINER	
MCLEAN, K	
ART UNIT	**PAPER NUMBER**
2185	11

DATE MAILED: 11/13/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Advisory Action

Application No.	Applicant(s)
08/935,844	Wilson et al.
Examiner	**Group Art Unit**
Kimberly McLean	2185

THE PERIOD FOR RESPONSE: [check only a) or b)]

a) ☒ expires 3 months from the mailing date of the final rejection.

b) ☐ expires either three months from the mailing date of the final rejection, or on the mailing date of this Advisory Action, whichever is later. In no event, however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

☐ Appellant's Brief is due two months from the date of the Notice of Appeal filed on _____ (or within any period for response set forth above, whichever is later). See 37 CFR 1.191(d) and 37 CFR 1.192(a).

Applicant's response to the final rejection, filed on Nov 1, 2000 **has been considered with the following effect, but is NOT deemed to place the application in condition for allowance:**

☒ The proposed amendment(s):

☐ will be entered upon filing of a Notice of Appeal and an Appeal Brief.

☒ will not be entered because:

☒ they raise new issues that would require further consideration and/or search. (See note below).

☐ they raise the issue of new matter. (See note below).

☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.

☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: See attached sheet

☐ Applicant's response has overcome the following rejection(s):

☐ Newly proposed or amended claims _____ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claims.

☐ The affidavit, exhibit or request for reconsideration has been considered but does NOT place the application in condition for allowance because:

☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

☒ For purposes of Appeal, the status of the claims is as follows (see attached written explanation, if any):

Claims allowed:

Claims objected to:

Claims rejected: 1-67

☐ The proposed drawing correction filed on _____ ☐has ☐has not been approved by the Examiner.

☐ Note the attached Information Disclosure Statement(s), PTO-1449, Paper No(s). _____ .

☐ Other

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After Final Response

Amended Claims

1. Applicant's amended claims have not been considered because they are new issues requiring a new search and further consideration. For example, claim 56, states, "for the group consisting of an intranet and the Internet..".

Response to Arguments

2. Applicant's arguments filed have been fully considered but they are not persuasive. In response to Applicant's argument that the Examiner points to no motivation in the prior art of record to make the further modification to the combined system of Yanai and Zarrow to replace the direct point-to-point communication link that Yanai teaches for communicating between the two storage systems, the Examiner's position states that Yanai's teachings are added to Zarrow's teachings. Yanai teaches coupling a secondary storage system to a primary storage via a communication link, thereby coupling the secondary storage system to a CPU via the primary storage system for the purpose of mirroring data without intervention of the host. Zarrow specifically teaches mirroring data through a network cloud (WAN). However, in doing so, Zarrow allows host intervention (mirroring software on host machine controls the mirroring operation) wherein the secondary storage is not coupled to the host (CPU) through a secondary storage system, which Yanai states degrades the performance of the system by overly burdening the host CPU with the task of writing the data to the secondary storage system and thus dramatically impacts and reduces system performance (C 2, L 17-25), which suggests the desirability of using Yanai's teachings. Thus one of ordinary skill in the art would have

recognized the performance benefits of the combined teachings of Zarrow and Yanai and would have been motivated to add the teachings of Zarrow to Yanai for improved performance. The Examiner has used the secondary reference for the specific teaching of coupling a secondary storage system to a host CPU via a primary storage system and not for using a point to point communication link. Therefore, motivation to replace the direct point-to-point communication link in Yanai's system is not provided as this feature was not relied upon. It should be noted that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

With regard to Applicant's statement that anyone using Yanai's teachings would have only known to use a point-to-point communication link, the Examiner disagrees. Anyone of ordinary skill in the art would have known that Yanai's teachings were directed to connecting a secondary storage system storage to a primary storage system to perform data mirroring without host intervention which provides improved performance and one of ordinary skill in the art would have also known of different implementations of communication links as point to point communication links were not the only type of communication links known at the time of the invention as is shown in the teachings of Zarrow. It is clear that the communication link in Yanai's system functions merely to couple two systems wherein the type of communication link used does not alter the fact that the secondary storage system is connected to the CPU via the primary storage system and not directly to the host CPU so that mirroring is performed without intervention from the host CPU.

3. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly McLean whose telephone number is (703) 308-9592 (e-mail address: Kimberly.McLean2@uspto.gov). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Do Yoo, can be reached on (703) 308-4908.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-9000.

Any formal response to this action intended for entry should be mailed to Commissioner of Patents and Trademarks, Washington, D.C. 20231 or faxed to (703) 305-9051 and labeled "FORMAL" or "OFFICIAL". Any informal or draft communication should be faxed to (703) 305-9731 and labeled "INFORMAL" or "UNOFFICIAL" or "DRAFT" or "PROPOSED" and followed by a phone call to the Examiner at the above number. Hand-delivered responses should be brought to Crystal Park II, 2021 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

KNM

November 8, 2000

Dothyun Yoo

DO YOO
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100